<u>REMARKS</u>

This application has been reviewed in light of the Office Action dated June 30, 2006. Claims 1, 3, 6,7, 9-17, 20-26, 29-31, 34, 39, 44, 47, 48 and 59-62 are presented for examination. Claims 1, 6, 7, 9-11, 14, 16, 17, 21-26, 29, 34, 39, 44, 47 and 48 have been amended to define still more clearly what Applicant regards as his invention. Claims 8, 18, 19, 27, 28, 32, 33, 35-38, 40-43, 45, 46 and 49-58 have been canceled without prejudice or disclaimer of subject matter, and will not be mentioned further.

Claims 59-62 have been added to provide Applicant with a more complete scope of protection. In particular, Claim 59 has been added which complements the subject matter of old Claim 27, but dependent from Claim 9. Claim 60 corresponds to old Claim 32, in dependent form based upon Claim 1. Claim 61 corresponds to old Claim 33, and is a "decoding" claim complementing the encoding method of Claim 1, to which new Claim 61 refers through dependency. Claim 62 depends from Claim 34 and qualifies the apparatus of Claim 34 in respect of an embedded system, described on page 37, lines 17 *et seq.*, and Fig. 5 of the present application.[1/]

Favorable reconsideration is requested.

Initially, Applicant has not received from the Office acknowledgment of the proper filing of the certified copy of his priority application. Since, however, PAIR confirms that the Patent and Trademark Office did receive the certified copy, Applicant assumes that the priority information that will be printed on the face of any patent that may

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[1/] It is of course to be understood that the claim scope is not limited by the details of this or any other particular embodiment that may be referred to.

issue from this application, will properly reflect Applicant's priority application, Australian application no. PQ8495, filed June 30, 2000.

In the outstanding Office Action, Claims 1-26 and 29-31 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In response, Applicant submits that the Examiner's apparent requirement to include tangible embodiment on a computer readable medium or hardware is not appropriate in respect of a method claim. Moreover, the rejection under Section 101 apparently centers on the argument that the claims in question are not "within the technological arts." Although the Examiner cites no authority for this alleged Section 101 requirement, Applicants suspect the Examiner is applying the holding of cases such as *Ex Parte Bowman*, 61 U.S.P.Q.2d 1669 (Bd. Pat. App. & Int. 2001) (non-precedential). However, the U.S. Court of Appeals for the Federal Circuit has never held this to be a requirement under Section 101, in cases such as *State Street Bank v. Signature Fin.*, 149 F.3d 1368 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Comm.*, 172 F.3d 1352 (Fed. Cir. 1999). The Board of Patent Appeals and Interferences has recently recognized this fact in *Ex Parte Lundgren*, Appeal No. 2003-2088, Appl. No. 08/093,516 (Bd. Pat. App. & Int. 2005) (*per curiam*) (precedential), where the Board wrote:

> "Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained." *Id.* at 7.

Accordingly, withdrawal of the rejection under Section 101 is respectfully requested.

In addition, Claims 1, 2, 4-15, 18, 34, 39, 44, 47 and 48 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,635,088 (Hind et al.), Claim 3,

under 35 U.S.C. § 103(a) as being obvious from *Hind* in view of U.S. Patent 6,785,673 (Fernandez et al.), and Claims 16, 17, 20-26 and 29-31 as being obvious from *Hind* in view of Applicant Admitted Prior Art (specifically, Figs. 2(a) and 2(b), and pages 1-3 and 18-23 of the present application).

Independent Claim 1 is directed to a method of generating an encoded representation of a markup language document comprising syntactic elements, comprising the step of parsing the markup language document to identify at least one syntactic element of that document. A type of the element is then identified, and the element is processed by applying a hash function thereto if the type is a first type, the hash function generating a numeric code from the element. Also, according to Claim 1, the encoded representation including the numeric code is generated if the type is the first type.

Thus, among other notable features of the method of Claim 1, is the application of a hash function to the syntactic element to thereby generate a numeric code from which the encoded representation is then generated. The specific advantages of the hash function encoding of the present invention are described on page 17, line 28, to page 18, line 11, and, as described, the use of such approach results in the generation of a numerical code in place of an input string. As noted on page 18, line 10, the implementation of a hash function allows faster numerical comparisons than string-to-string comparisons.

In contrast, *Hind* is seen to describe, expressly, a simple order-based string substitution approach such as the type specifically taught away from by the present invention, as described on page 18 and noted above. The order-based string substitution of

Hind is clearly seen in steps 480, 485 and 490 of Fig. 4B described generally at col. 10, line 64, through col. 12, line 25, of *Hind*.

Applicant notes, however, the statement in the Office Action (regarding Claim 3) that "Hind teaches a hash algorithm". Applicant cannot agree: *Hind* has been thoroughly reviewed, and no disclosure or suggestion of a hash algorithm has been found therein. In fact, a text search of *Hind* does not even reveal the term "hash". As noted above, *Hind* uses order-based string substitution to effect compression, and not a hash function.

As a consequence, Applicant believes that Claim 1 is clearly allowable over *Hind*.

Regarding the Applicant's Admitted Prior Art, Applicant notes that there is no suggestion contained in the AAPA of how an approach like that of *Hind* should (or even could) be modified to include well-formedness checking. The *Hind* system merely constructs a flat table of substituted tags that ignores the hierarchical structure (nesting) of the tags (see *Hind* at col. 13, lines 27-30). Further, to attempt to alter *Hind* would, in any case, make the *Hind* system unfit for its intended purpose of compression. Accordingly, the proposed combination of *Hind* and AAPA is not believed to be one that one of merely ordinary skill would attempt, nor would there be a reasonable expectation of success if such combination were to be attempted.

For all these reasons, it is submitted that Claim 1 is allowable over *Hind*, taken alone, or in any possible combination with the AAPA (assuming such combination would even be a permissible one).

Each of the other independent claims contains recitations similar in pertinent respects to Those discussed above with regard to Claim 1, and therefore also are believed to be patentable for at least the same reasons as discussed above in connection with Claim 1.
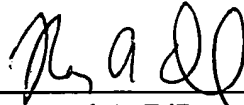
A review of the other art of record, including *Fernandez*, has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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